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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/768,774	01/30/2004	Ulrich Birbaum	DT-6747	7066
30377	7590	01/03/2006	EXAMINER	
DAVID TOREN, ESQ. ABELMAN FRAYNE & SCHWAB 666 THIRD AVENUE NEW YORK, NY 10017-5621			ZIMMERMAN, JOHN J	
			ART UNIT	PAPER NUMBER
			1775	

DATE MAILED: 01/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/768,774

Applicant(s)

BIRNBAUM ET AL.

Examiner

John J. Zimmerman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/7/05 (election).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 7-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20040930</u> . | 6) <input type="checkbox"/> Other: _____ |

FIRST OFFICE ACTION

Election/Restrictions

1. Claims 1-10 are pending in this application. Claims 7-10 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention. Election of Group I, claims 1-6, was made without traverse in the reply filed on October 7, 2005.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

3. The Information Disclosure Statement received September 30, 2004 has been considered. An initialed form PTO-1449 is enclosed with this First Office Action.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-4 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Poschmann (DE 19740101).

6. Poschmann discloses a hollow profile (e.g. aluminum, steel) having four substantially flat sidewalls and at least one groove on one of the side walls wherein the maximum groove depth "t" is the wall thickness "s" (e.g. see Figure 1; column 2, lines 20-29).

7. Claims 1-5 are rejected under 35 U.S.C. 102(a) as being anticipated by Birnbaum (U.S. Patent Application Publication 2003/0159397).

8. Birnbaum (different inventive entity than the pending application) discloses a hollow sheet metal profile having four substantially flat sidewalls and at least one groove on one of the side walls wherein the maximum groove depth "t" is the wall thickness "s" and having at least one mounting opening in the at least one groove (e.g. see Figure 1; paragraph [0023]).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Birnbaum (U.S. Patent Application Publication 2003/0159397) as applied to claims 1-5 above, and further in view of Poschmann (DE 19740101).

11. Birnbaum (different inventive entity than the pending application) discloses a hollow sheet metal profile having four substantially flat sidewalls and at least one groove on one of the side walls wherein the maximum groove depth "t" is the wall thickness "s" and having at least one mounting opening in the at least one groove (e.g. see Figure 1; paragraph [0023]). Birnbaum may differ from claim 6 in that Birnbaum may not require that his mounting member be made of steel. Poschmann, however, clearly shows that steel is considered a particularly suitable material for mounting members (e.g. see column 2, lines 2-11). In view of Poschmann, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use steel for the mounting member of Birnbaum because Poschmann discloses that steel is understood to be a particularly suitable material in the art for mounting members.

12. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Poschmann (DE 19740101) as applied to claims 1-4 and 6 above, and further in view of Birnbaum (U.S. Patent Application Publication 2003/0159397) or Sedlmeier (U.S. Patent 5,927,041).

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13. Poschmann discloses a hollow profile (e.g. aluminum, steel) having four sidewalls and at least one groove on one of the side walls wherein the maximum groove depth "t" is the wall thickness "s" (e.g. see Figure 1; column 2, lines 2-29). Poschmann's mounting rail may differ from claim 5 in that Poschmann may not require a mounting opening formed on the bottom of the at least one groove. Birnbaum (e.g. see Figure 1) and Sedlmeier (e.g. see Figure 3) clearly show that it is conventional in the prior art to form mounting openings in the bottom of grooves in mounting rails in order to facilitate fixing objects to the rails. In view of Birnbaum or Sedlmeier, it would have been obvious to one of ordinary skill in the art at the time the invention was made to form the mounting rail of Poschmann with mounting openings in the grooves in order to facilitate mounting objects on the rails.


Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The additional art of record serves to further establish the level of ordinary skill in the art at the time the invention was made.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Zimmerman whose telephone number is (571) 272-1547. The examiner can normally be reached on 8:30am-5:00pm, M-F. Supervisor Deborah Jones can be reached on (571) 272-1535. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John J. Zimmerman
Primary Examiner
Art Unit 1775

jjz
December 22, 2005